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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/734,513

12/12/2003

Dennis McGinn

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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

05/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/734,513

**Applicant(s)**

MCGINN ET AL.

**Examiner**

Jamisue A. Plucinski

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9-18,23-28,32 and 35-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9-18,23-28,32 and 35-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20070416, 20031212</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In response to Preliminary Amendment filed 3/10/06.
2. Claims 1, 2, 4-6, 9-18, 23-28, 32, 35-68 are pending.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 4/16/07 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (specifically reference DE 3908029). It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 6, 17, 35-37, 46, 47 and 56 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. With respect to Claims 5 and 17: the phrase "and therefore of said keys" is indefinite. It is unclear to the examiner what the term "therefore" is referring to, therefore causing the phrase to be unclear.

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7. With respect to Claim 6: the phrase “health check” is indefinite. It is unclear to the examiner as to the health check of what? The user? The box?

8. With respect to Claims 35, 46 and 47: the phrase “transmission of D) activates one or more alarms” is indefinite. It is unclear to examiner if this is information that is transmitted, or this is referring to step D, in Claim 27.

9. With respect to Claim 36: the phrase “said one or more alarms include...” is indefinite. It is unclear to the examiner if the claim is claiming that the alarms are “one of” the alarms listed, or if all of the alarms listed are activated with the transmission of step D. The claim allows for there to be only one alarm, therefore it is unclear how the alarms is now multiple alarms.

10. With respect to Claim 37: “the transmission indicates...” is indefinite. It is unclear to the examiner if the transmission indicates both a sales event and a demo drive time, or if the transmission indicates either one or the other of them. If a vehicle is only a demo drive and does not result in a sales, does the transmission happen? Or does it only happen if a sales event happens?

11. With respect to Claim 56: the claim has indented “a system computer” and “a plurality of access ID cards” twice to indicate that these limitations are present in each of the vehicle activity modules, therefore causing the claim to be unclear if each of the vehicle activity modules has a system computer, or if the system computer is part of the whole system. The examiner suggest fixing the indentations to indicate more clearly that the system computer and the plurality of access ID cards are part of the system and not part of each of the vehicle activity modules.

12. Claim 56 recites the limitation "said central computer". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 16-18, 23-26, 32, 35, 40, 41, 43, 45, 46, 53-56, 58, 60-62 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wunderlich et al. (6,611,232) in view of Flick (6,737,961).

16. With respect to Claim 16: Wunderlich discloses a vehicle activity module for maintaining security and data gathering for a plurality of vehicles, to be used in cooperation with a central computer, personal ID cards, for access to vehicle keys (see abstract), the vehicle activity module comprising:

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- a. a housing having a releasable key compartment, said housing being securely mounted to some portion of each said plurality of vehicles (See Figures 1 and 2 with corresponding detailed description);
- b. at least one ID reader by which ID information can be scanned from said personal ID cards (Column 6, lines 1-17); and
- c. a wireless transmitter by which said personal ID card information can be transmitted to a central computer for storage and analysis (See Reference numeral 280 with corresponding detailed description).

17. Wunderlich however fails to disclose the use of key ID tags and a reader which can read key tag information.

18. Wunderlich discloses the use of vehicle keys, however fails to disclose the use of key ID tags, which are attached to vehicle keys and sensors read information from the key ID tag. Flick discloses the use of secure vehicle keys where the keys either have a key tag ID for identification and transmit signals to wireless receivers (See Figure 3 with corresponding detailed description, and Column 2, lines 1-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Wunderlich, to include the key ID tags of Flick, in order to reliably control access to the keys as well as track whether the keys are in the actual device. (See Flick, Columns 1 and 2)

19. With respect to Claim 17: Flick discloses the use of the key ID tag information includes the presence or absence of said key ID tags and therefore of said keys within said vehicle activity module (Column 2, lines 61-65).

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20. With respect to Claim 18: Wunderlich discloses the vehicle activity modules operates in sleep mode until awakened by an event to report activity (Column 7, lines 6-19).

21. With respect to Claim 23: Wunderlich discloses the use of an intrusion alarm (Column 3, lines 34-47).

22. With respect to Claim 24: Wunderlich discloses the ID reader is a magnetic strip reader (Column 6, lines 1-17).

23. With respect to Claim 25: Wunderlich and Flick disclose the use of wireless readers and transmitters, however fail to disclose the ID reader is an RFID reader. The examiner takes official notice that the use of RFID readers for wireless transmitting of identification purposes, specifically in tags, is old and well known in the art. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wunderlich and Flick, to have their wireless transmitters to RFID reader, for ease of use of what is readily available in the art.

24. With respect to Claim 26: Flick discloses the ID reader is key tag/ID reader (See abstract).

25. With respect to Claim 32: Flick discloses the sensors include a key ID tag sensor (see abstract)

26. With respect to Claim 35: Wunderlich discloses the transmission of information activates one or more alarms by the central computer upon receiving said transmission from said vehicle activity module (Column 3, lines 34-47).

27. With respect to Claim 40: Wunderlich discloses the transmission indicates an intrusion event (Column 5, lines 29-45).

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28. With respect to Claim 41 and 43: Flick discloses the key tag is checked whether it is the correct key when the key container is opened (Column 6, lines 47-57).

29. With respect to Claim 45: Wunderlich discloses the activity sensors include an intruder sensor, which if activated, cause one or more alarms to be activated (column 3, lines 33-47).

30. With respect to Claim 46: Wunderlich discloses the transmission of step D) is a regularly timed signal, which if not received by said central computer, cause one or more alarms to be activated (Column 5, lines 18-29).

31. With respect to Claims 53 and 54: Wunderlich discloses the use of generating reports (Column 6, lines 17-34).

32. With respect to Claim 55: Wunderlich discloses the transmission indicates an intrusion event, and event data are recorded in said central computer, along with vehicle data, which can be organized into reports for security planning and police reports (Column 5, lines 8-17 and Column 6, lines 17-34).

33. With respect to Claim 56: Wunderlich discloses the use of an inventory management system for a plurality of vehicles comprising:

d. A Plurality of vehicle activity modules (See Figure 2 with corresponding detailed description) each comprising:

i. An identification number to uniquely identify the vehicle activity module (see abstract);

ii. A wireless transmitter (See Reference numeral 280 with corresponding detailed description)

iii. An activity sensor (Column 5, lines 40-45)



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- iv. A key container to receive a key (Figure 2, with corresponding detailed description).
- e. A system computer having a database for data storage and in communication with each of the transmitters of the plurality of vehicle activity modules (Column 5, lines 8-17);
- f. A plurality of access ID cards having unique identification numbers and are used to gain access to the key contained in the vehicle activity module (Column 6, lines 1-17).
- g. Wherein the activity sensor reads the unique ID number of the ID card and verifies if the card has authorized access to the key in the vehicle activity module (Column 6, lines 1-17).

34. Wunderlich however fails to disclose the use of a key sensor that detects the key in the key container. Flick discloses the use of secure vehicle keys where the keys either have a key tag ID for identification and sensors which detect the presence of the key in a container (See Figure 3 with corresponding detailed description, and Column 2, lines 1-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Wunderlich, to include the key ID tags of Flick, in order to reliably control access to the keys as well as track whether the keys are in the actual device. (See Flick, Columns 1 and 2)

35. With respect to Claim 58: Wunderlich discloses the use of an alarm coupled to the activity sensor, where the alarm is activated upon an intrusion event (column 3, lines 33-47).

36. With respect to Claim 60: Flick discloses the use of a second key sensor which is used to detect if the correct key is in the correct vehicle activity module (Column 6, lines 47-67).

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37. With respect to Claim 61: Flick discloses the key sensor is embedded in the key (See Figure 2).

38. With respect to Claim 62: Flick discloses the use of a plurality of key tags which are attached to a vehicle key and embedded with a unique key tag identification number, and wherein the second sensor detects the key tag identification number to determine if the key operates the vehicle (See Figure 3).

39. With respect to Claim 65: Flick discloses an alarm is activated when the second sensor detects the improper key is in the vehicle activity module, where the alarm is an audio alarm or an e-mail notification (See Column 6, lines 47-67).

40. Claims 1, 2, 4-6, 9-15, 27, 28, 37-39, 42, 44, 47-52, 57, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wunderlich et al. (6,611,232) in view of Flick (6,737,961) and Ohta et al. (US 2002/0147981).

41. With respect to Claims 1, 27, 47, 48, and 52: Wunderlich discloses the use of a system and method for maintaining security and gathering data for a plurality of vehicles (see abstract) comprising:

- h. a vehicle activity module attached to each vehicle (abstract, and reference numeral 110 with corresponding detailed description), said vehicle activity module including:

- v. a wireless transmitter (See Reference numeral 280 with corresponding detailed description),

- vi. sensors (Column 5, lines 40-45) and

- vii. a key container (See Figure 2);
  - i. a central computer having a database for data storage, said central computer being in wireless communication with each of said vehicle activity modules (Reference numeral 170 with corresponding detailed description);
  - j. personal ID cards which are issued to sales, maintenance and service personnel (Column 6, lines 1-17);
  - k. wherein the vehicle activity module operates in sleep mode until awakened and information read from personal ID cards (Column 7, lines 6-19) by said sensors is transmitted to said central computer for and recording of access activity (Column 6, lines 1-17); and activity information is transmitted to said central computer for storage and analysis (Column 5, lines 8-17 and column 6, lines 1-17).
- 42. Wunderlich discloses the use of vehicle keys, however fails to disclose the use of key ID tags, which are attached to vehicle keys and sensors read information from the key ID tag. Flick discloses the use of secure vehicle keys where the keys either have a key tag ID for identification and transmit signals to wireless receivers (See Figure 3 with corresponding detailed description, and Column 2, lines 1-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Wunderlich, to include the key ID tags of Flick, in order to reliably control access to the keys as well as track whether the keys are in the actual device. (See Flick, Columns 1 and 2)
- 43. Wunderlich teaches the use of access authorization to the lockboxes, however fails to disclose the information is sent to the central server for access authorization (rather Wunderlich teaches the authorization is done locally on the lock box). Ohta discloses the use of a locker

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system for temporary access of rented items, where access to the locker or storage area is verified by the central server (Paragraph 0035). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wunderlich with the authorization being done at the central server, as disclose by Ohta, in order to increase control and allow for locker management by a central system (See Ohta abstract, and Pages 2 and 3).

44. With respect to Claims 2, 28, 49 and 50: Wunderlich discloses the vehicle activity modules operate in sleep mode until awakened by an event to report activity, and there the event is chosen from a group of events consisting of sales events, non-sales events and intrusion events (Column 17, lines 9-19 and Claim 16).

45. With respect to Claims 4 and 51: Wunderlich discloses the vehicle activity module operates in sleep mode until awakened at periodic programmed intervals to report on status (Column 5, lines 18-29).

46. With respect to Claim 5: Flick discloses the key ID tag information includes the presence or absence of said key ID tags and therefore of said keys in said vehicle activity modules (See Flick Column 1, lines 61-65).

47. With respect to Claim 6: Wunderlich discloses the sensors determine if there is a loss of power (column 5, lines 29-39), the examiner considers this to be a health check due to the fact that it cannot function properly if there is no power.

48. With respect to Claim 9: Wunderlich discloses the use of an intrusion sensor (Reference numeral 294 with corresponding description).

49. With respect to Claims 10-12: See Flick, Column 4, lines 8-27.

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50. With respect to Claim 13: Wunderlich and Flick discloses the information from said ID cards and key ID tags is used to generate alerts and theft alarms (See Wunderlich Claim 16 and Column 6, lines 1-17 and Flick Column 6, lines 48-58).

51. With respect to Claim 14: Wunderlich discloses the generation of reports (Column 6, lines 17-34).

52. With respect to Claim 15: Wunderlich discloses the ID cards are used to access the key, which is used to access the vehicle (Column 6, lines 1-17) and Flick discloses the key IS tags are used to access the vehicle (Column 2, lines 46-56).

53. With respect to Claims 37, 38, 39, 42, 44, 63 and 64: Wunderlich and Flick disclose the key sensor and detecting when the item was accessed for a demo drive, sales event or maintenance and discloses noting if the item is accessed during working hours or non-working hours (See Wunderlich abstract), however fails to specifically disclose to a predetermined limit of access and where an alarms is sounded when the limit is exceeded. Ohta discloses the use of a sensor for the locker system, where once something is removed a time clock is started and the user is notified when the item needs to be returned, and if not returned within the limit an action is taken, such as charging the user for the extra time (See Paragraphs 0019, 0020, 0037 and 0038). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Wunderlich and Flick, to include the feature of setting a time limit, as disclosed by Ohta, in order to control when and how long things are rented or loaned out (See Ohta Page 1).

54. With respect to Claim 57: See Ohta, Paragraph 0035.

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55. Claims 36, 59, and 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wunderlich, Flick and Ohta as applied to claims 1, 27, 47, 48, and 52, above, and further in view of Carter (5,373,282).

56. With respect to Claims 66-68: Wunderlich discloses the use of generating reports, however fails to disclose the use of a user interface in communication and remote from the system computer, which accesses the system computer via LAN or the internet and receives a vehicle description and a report is generated on the location of the vehicle. Carter discloses the use of a user interface (Column 10, line 59 to Column 11, line 18), which reports on location of the vehicle (Column 9, lines 3-17) and is connected using a LAN (Carter discloses everything is done at a dealership, therefore the examiner considers this to be all done locally, therefore connected using a LAN, Carter also discloses the computer being connected using a modem 106, with other computer systems). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wunderlich to include the user interface, as disclosed by Carter, in order to aid and increase dealer management of the storage devices (See abstract, and Column 3).

57. With respect to Claims 36 and 59: Carter discloses the alarm alerts police when an intrusion occurs (Column 11, lines 38-45).

### ***Conclusion***

58. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maloney (US 2002/0044055 and US 2002/0075154) disclose the use of centralized storage for vehicle keys, and Greenman (US 2003/0179075), Fisher (7,009,489), Harold et al.

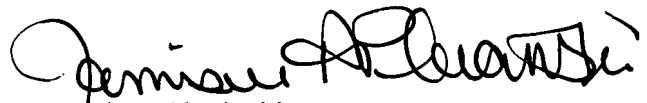
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(6,472,973) and Kuenzi et al. (US 2004/0025039) discloses the use of lockbox systems for accessing a key.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Plucinski  
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